

Appl. No.: 10/608,279
Atty Docket: CG-851D
Inventor: Francois et al.

REMARKS

Reconsideration of above referenced application is respectfully requested. After entry of the instant office action response, Claims 1-23, 25 and 26 remain in the pending application. Claim 24 was canceled. On April 5, 2005, Applicant's attorney and the Examiner conducted an interview. Applicants' attorney thanks the Examiner for her time and effort in conducting the interview. Prior to the interview, Applicants' attorney submitted potential claim amendments. During the interview, the Examiner did not agree with assertions that the prior art did not teach the claimed invention. Specifically, the Examiner simply dismissed, incorrectly, Applicants' assertions that in some circumstances functional language can be novel. Applicants' attorney, herein, has provided case law to which reinforces the Applicants' position that functional language may establish novelty where such function is not inherent in the prior art, as is the case in the pending application. Applicants' attorney has amended independent claims 1, 7, 12, 17 and 23.

35 U.S.C. § 112, Rejection of Claim 25-26

The Examiner has rejected Claims 25-26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. However, during the interview Applicants' attorney asserted to the Examiner that the limitation at issue is shown in the Figures and therefore the rejection was improper. Applicants' attorney believes that the Examiner agreed and therefore no amendment has been made to those limitations.

35 U.S.C. § 102(b), Rejection of Claims 1-23

The Examiner has rejected Claims 1-23 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,844,422 issued to Schmalz or U.S. Patent No. 3,785,045, issued to Komendowski. Applicants' attorney has amended independent claims 1, 7, 12, 17, 22 and 23, rendering this ground of rejection moot.

The Examiner alleges that Schmalz discloses, in Figures 1-3, a molded closure having an auxiliary helical thread of a first depth and a first pitch, a principle thread of a second thread

Appl. No.: 10/608,279
Atty Docket: CG-851D
Inventor: Francois *et al.*

depth and a second pitch, the second thread depth and second pitch are greater than the first thread depth and first pitch, the closure side wall comprising a first tier and a second tier, wherein the auxiliary thread is disposed on the first tier and the principle thread is disposed on the second tier.

Anticipation "requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee." *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302 (Fed. Cir. 1995). "[P]rior knowledge by others requires that all of the elements and limitations of the claimed subject matter must be expressly or inherently described in a single prior art reference." *Elan Pharms., Inc. v. Mayo Foundation for Medical Educ. & Research*, 304 F.2d 1221, 1227 (Fed.Cir. 2002).

Claim 1, as amended herein requires in part that the auxiliary thread have a first depth and the principle thread have a second depth wherein the second depth is at least about twice the first depth. Alternatively stated, Claim 7 requires the auxiliary thread having a first depth and the principal thread having a second depth, the first depth being less than about one-half the second depth. Stated in yet another way, Claim 12 requires the second depth is greater than the first depth by a factor of at least two. Claims 17 and 23 each require that the depth of the auxiliary thread is about at least one-half the thread depth of the principal thread. As originally drafted, Claim 22 requires that the first thread depth is about double the second thread depth. The claim amendments are supported at page 9 of the Specification. As set forth on page 9 at line 16, "the depth d_1 of the auxiliary thread 20 need only be great enough to provide sufficient engagement between an incomplete molded closure, or short shot, and the molding cavity, so the depth d_1 may be significantly less than the depth d_2 of the principal thread 40. For example, the depth d_1 may be as small as one-half or one-tenth the depth d_2 ". The amended claims and new Claim 25 reflect this relationship.

Further Applicant's attorney has amended the claims to require the threads to extend from substantially equivalent radial locations of the sidewall. By contrast Schmalz and Komendowski fail to teach such limitation.

Appl. No.: 10/608,279
Atty Docket: CG-851D
Inventor: Francois et al.

Schmalz discloses a closure 1 have threads 2 disposed along the inner side wall of the closure. Above the threads 2 are ribs for projections 7 which retain a liner in place above the threads 2 and beneath the top wall of the closure 1. Evidencing the function of the projections or threads 7 to retain a liner, the specification states on page 2 at line 73 "the liner engaging threads must have a finer pitch in order to properly engage the thin edge portions of the liner." When Schmalz teaches fine and coarse threads, this is related to pitch, i.e. the distance between the same point of consecutive rotations. This is not related to thread depth, i.e. the distance radially inward from the closure sidewall. As Applicants' attorney explained to the Examiner during the interview, the pitch of the upper thread or rib is taught to be fine to increase engagement between the liner material and the threads. This is not related to thread depth but instead pitch to maximize contact and provide a seal. Contrary to claimed limitation, the Schmalz reference fails to teach or disclose an auxiliary thread which is at least one-half the depth of the primary thread. Moreover, the Schmalz reference fails to teach the primary and auxiliary thread extending from substantially equivalent radial locations of the sidewall.

The Examiner also alleges that U.S. Patent No. 3,785,045, issued to Komendowski anticipates the instant claimed invention and teaches a molded closure having an auxiliary helical thread having a first depth and a first pitch and a principle thread having second depth and a second pitch, the second thread depth and second pitch are greater than the first thread depth and the first pitch, the closure side wall comprising a first tier and a second tier, wherein the auxiliary thread is disposed on the first tier and the principle thread is disposed on the second tier.

To the contrary, the Komendowski reference teaches a combination container and closure therefore. The container has a sealed neck portion for storage of a product within the container. The closure or end cap comprises a cutting blade which severs the sealed top wall of the container neck so that once the closure is in place the closure may be rotatably opened to dispense the product within the container. The closure comprises a fine thread disposed on an inner wall of the annular portion and a coarse thread located on an inner wall of the outer closure skirt. However, the Komendowski reference fails to disclose an auxiliary thread having a first depth and a principle thread having a second depth wherein the second depth is at least about

Appl. No.: 10/608,279
Atty Docket: CG-851D
Inventor: Francois et al.

twice the first depth or primary and auxiliary threads extending from substantially equivalent radial locations.

Since the Schmalz reference and the Komendowski reference each fail to teach all of the elements of the amended claims, Applicants' attorney respectfully requests this ground of rejection withdrawn.

35 U.S.C. § 103(a), Rejection of Claims 25-26

The Examiner has rejected Claims 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Schmalz in view of Gibson (3,690,496). Schmalz does not disclose the auxiliary and primary thread extending from equivalent locations of the cylindrical side wall. However, the Examiner alleges that Gibson teaches a closure having an auxiliary thread and a primary thread extending from equivalent radial locations of the cylindrical side wall. Therefore, the Examiner recites, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the Schmalz closure having the auxiliary thread and primary thread extending from equivalent radial locations of the side wall as taught by Gibson in order to correspond to a type of container neck or gasket seal.

First, the Examiner is reminded of the amended limitation which states that the auxiliary thread is disposed "to inhibit engagement of the auxiliary thread and the container neck finish". Thus, the Examiner's statement that the auxiliary thread may be made to "correspond to a type of container neck or gasket seal" is an improper misstatement.

As the Examiner is well aware, in rejecting claims under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. See In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q.2d 1955 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). Here the Examiner has not represented a *prima facie* case of obviousness as to any of the rejected claims. A *prima facie* case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 26 U.S.P.Q.2d 1529 (Fed.

Appl. No.: 10/608,279
Atty Docket: CG-851D
Inventor: Francois et al.

Cir. 1993); In re Rinehart, 531 F.2d 1048, 189 U.S.P.Q. 143 (C.C.P.A. 1976). Where the Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This is not to say, however, that the claimed invention must expressly be suggested in any one of or all of the references. Rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See Cable Electric Products, Inc. v. Genmark, Inc., 770 F. 2d 1015, 226 U.S.P.Q. 881 (Fed. Cir. 1985); In re Kaslow, 707 F. 2d 1366, 217 U.S.P.Q. 1089 (Fed. Cir. 1983); In re Keller, 642 F.2d 413, 208 U.S.P.Q. 871 (C.C.P.A. 1981).

Here the applied references also are not combinable. It has been long recognized that references are not properly combinable where none of the cited references suggests the desirability of the inventive combination. See Application of Imperato, 179 U.S.P.Q. 730 (C.C.P.A. 1973) cited by the CAFC for the same proposition in In re Sernaker, 217 U.S.P.Q. 1 (Fed. Cir. 1983), and In re Gordon, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Further, prior art references must be considered in their entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). While a reference can be utilized for all that it teaches, focusing upon isolated portions of the reference or picking and choosing only that which supports a holding of obviousness is improper. Pertinent in this regard are also Panduit Corp. v. Dennison Mfg. Co., 1 U.S.P.Q. 2d 1593, 1602 (Fed. Cir. 1987) and In re Wesslau, 147 U.S.P.Q. 391 (C.C.P.A. 1965). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). That is not the case here.

Here, the Examiner's rejection is improper since there is no suggestion to make the cited combination of prior art references. Specifically, the '496 patent, issued to Gibson, teaches threads which extend from a side wall of a closure. The thread depths are equivalent so that "when removing the cap, the bead interferes with the lower thread portion of the cap providing resistance to easy removal". In other words, the upper threads engage the upper thread of the

Appl. No.: 10/608,279
Atty Docket: CG-851D
Inventor: Francois *et al.*

neck finish and the lower threads interfere with the upper thread and a neck bead during removal of the cap to inhibit such removal and make the closure child-resistant. As recited in the instant claims, the auxiliary threads are not engaged by the container neck finish. Thus, the depth of the auxiliary thread is at least one-half the depth of the primary thread. That is not taught in the Gibson reference. Further, such teaching is not found either alone or in combination with the Schmalz reference. Schmalz teaches an upper thread and a lower thread wherein the upper thread has a fine pitch as compared to the lower thread. A fine pitch does not teach or otherwise suggests the limitation that the auxiliary thread be less than one-half the depth of the primary thread. Moreover, since the Schmalz reference teaches that the upper threads are disposed along an upper wall and the lower threads are disposed along a lower side wall having a larger radial distance, such teaching would inhibit the interference that is necessary for proper operation of the Gibson closure. Thus, the Examiner is reminded that in making a combination, the Examiner may not change the function of a cited prior art reference. Specifically, the Examiner is directed to MPEP § 2143.01 which states "if a proposed modification would render the prior art invention being modified unsatisfactorily for its intended purpose, then there is no suggestion or motivation to make the proposed modification." See *In re Gorman*, 733 F.2d 900 (Fed. Cir. 1984). Thus, to summarize there is no suggestion to make the cited combination since such combination would change or modify one of the cited prior art references from its intended use and further since the combination fails to teach all of the claimed limitations of the Applicants' pending claims.

Comments Regarding Interview

During the interview, the Examiner alleged that the amended claim limitation stating the auxiliary thread does not engage the container neck is new matter and is not supported in the application. This is incorrect.

At page 4, line 3, the disclosure teaches that "the second closure thread or principal thread serves as fastening means between the closure and ...container." Inherent in such statement is the fact that the auxiliary thread does not engage the container neck finish. Moreover, the auxiliary thread is discussed in the same paragraph and is never taught or otherwise suggested to engage the container neck finish. Further the Examiner is directed to the paragraph beginning at

Appl. No.: 10/608,279
Atty Docket: CG-851D
Inventor: Francois *et al.*

line 4, page 5 which indicates the limited nature of the auxiliary thread to engage the mold core, rather than the container neck finish. Therefore, such limitation is contained in the specification and is not new matter. For the Examiner to assert otherwise is improper and indicates that the Examiner is applying the teachings of the prior art to the structure of the instant invention.

During the interview the Examiner admitted that not all of the claimed elements were shown by the prior art Schmalz and Komendowski references. In other words, the § 102 rejections are not proper. However, the Examiner stated that all of the structure would be shown by combining either of those references with Gibson. In making that statement, the Examiner simply dismissed all of the functional recitation as irrelevant. To the extent that the Examiner alleges that such an obviousness rejection is proper, Applicant's attorney provides the following to point out the Examiner's error.

Applicants' attorney has amended the pending independent claims with functional language reciting that the auxiliary thread engages a mold core thread and enables removal of said closure from said mold core after a short shot. Further, the language recites that the primary thread engages a container neck finish and that the auxiliary thread is disposed to inhibiting engagement of the container neck finish. Applicants' attorney discussed such claim limitations during the interview with the Examiner. However, the Examiner simply dismissed the language as not rendering the claimed invention novel. Such out-of-hand dismissal of the functional recitation was improper.

The Examiner recited the well founded general rule that the recitation of a new intended use for an old product does not make a claim to that old product patentable. See *In re Spada*, 911 F.2d 705 (Fed. Cir. 1990). As a broad general rule the Examiner's statement is correct. However, the courts have also stated that an Applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*, 439 F.2d 210 (CCPA 1971). ("There is nothing intrinsically wrong with defining something by what it does rather than what it is in drafting patent claims."). The court further stated that drafting claims with functional recitation carries with it a risk. "Where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an

App. No.: 10/608,279
Arty Docket: CG-851D
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inherent characteristic of the prior art, it posses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on." *Id* at 213. Thus, where the Applicant asserts that novelty is partially based on the claimed functionality, the Examiner may not simply dismiss the argument but must further ask whether such functionality is inherent in the prior art. This was the Examiner's mistake during the interview.

During the interview Applicants' attorney asserted that the functional limitations recited in the pending claims were critical to the novelty of the invention however the Examiner did not look into whether such functionality was inherent in the prior art, but instead simply dismissed the language. To the contrary, such functional recitation should be given patentable weight where the functional limitation is not inherent in the prior art. In this situation the prior art references do not teach, explicitly or inherently, an auxiliary thread directed to engage a mold core thread and enable removal of the closure from the mold core after a short shot. Further, the cited prior art references do not teach an auxiliary thread which is disposed at a first end of the side wall to inhibit engagement of the auxiliary thread and the container neck finish, either explicitly or inherently. To the contrary, the '045 patent, the '442, and the '496 patent all teach upper threads which engage a container neck. Thus, it would be illogical for the Examiner to argue that the functionality claimed in Applicants' pending application are inherent or explicit in the cited prior art. These claim limitations, therefore, cannot be ignored.

Further to this point, the Examiner asserts that it is irrelevant that the instant pending claims recite an auxiliary thread directed to engage a mold core thread and enable removal of said closure from said mold core after a short shot and further that the auxiliary thread is disposed at a first end of said side wall to inhibiting engagement of the auxiliary thread and container neck finish. However, these claim limitations cannot be ignored as previously indicated. See *Perkin-Elmer Corp. v. Westinghouse Elc. Corp.*, 822 F.2d 1528 (Fed. Cir. 1987) (The court cannot ignore a plethora of meaningful limitations). Patentability is determined for the invention as claimed, *with all its limitations*. It is improper for the Examiner to delete explicit limitations from the claim in order to find the residual limitations in the prior art.

Appl. No.: 10/608,279
Atty Docket: CG-851D
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Finally, Applicants' closure design is not described in the prior art. Statements in the claims that define and limit the device are material limitations, for purposes of infringement *and for purposes of distinguishing from the prior art*. See *Rowe v. Dror*, 112 F.3d 473 (Fed. Cir. 1997) (emphasis added). Moreover, the Federal Circuit has held that functions stated in a claim distinguish from the prior art. See *In re Stencel*, 828 F.2d 751 (Fed. Cir. 1987). Thus, the rejection for lack of novelty cited by the Examiner during the interview is simply incorrect since the Examiner cannot merely dismiss functional language but, instead, must consider such language in limiting a claimed invention with respect to the prior art.

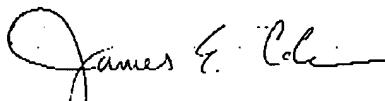
CONCLUSION

Applicants' attorney believes that the instant application is now in condition for allowance and therefore respectfully requests that the Examiner allow the pending claims. However, if the Examiner believes there are other unresolved issues in this case, Applicants' attorney of record would appreciate a call at (502) 584-1135 to discuss such remaining issues.

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Respectfully submitted,

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